



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,981	01/02/2004	Jie Wu	ALL003	5199
35830	7590	07/28/2005	EXAMINER	
LAWRENCE N. GINSBERG 21 SAN ANTONIO NEWPORT BEACH, CA 92660-9112			PATEL, PARESH H	
			ART UNIT	PAPER NUMBER

2829

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,981	WU, JIE	
	Examiner	Art Unit	
	Paresh Patel	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10-13, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 14-16 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>0705</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites, inter alia, two device interfaces 130 and 230, each of which is connectable to a corresponding group of electronic devices 182 and 282 **through a second connection**, wherein "a second connection" is not enabling from the disclosure because it is not described in the specification or in the drawing (particularly in elected fig. 2-3). Loader/unloader 150 of fig. 2-3 can't be a second connection because it is individually claimed in claim 4 (and hence it is different from a second connection), wherein claim 4 is depends from claims 3, 2 and 1. Therefore, a second connection as claimed is not clear from the specification or drawing to make and use the invention.

Dependent claims 2-5 and 7-9 are also rejected because they depend from rejected claim 1.

Art Unit: 2829

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, what is not clear is "a second connection". It is indefinite because second connection is not defined in the specification or shown in the drawing to understand how it related to device interface 130/230 and group of electronic devices as claimed.

Dependent claims are also rejected because they depend from rejected claim 1.

With respect to claims 1-5 and 7-9 art can't be applied.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi (US 6225798, fig. 5-7) in view of Onishi (US 6225798, fig. 8 and 5).

Regarding claim 14, Onishi et al. (hereafter Onishi) in fig. 5-7 discloses a method of automatically testing electronic devices comprising the steps of:

in a primary test cycle,

(a) connecting a first group of electronic devices [ICs 13 under test loaded on tray 1] to a tester interface [15a or test station TS1] for testing [using 1a and 1b, see fig. 5];

(b) disconnecting [from test station TS1 for TS2] the first group of electronic devices from the tester interface upon completion of the testing;

(c) connecting a second group of electronic devices [ICs of tray 2] to the tester interface [TS1] for testing;

(d) disconnecting [from TS1 for TS2] the second group of electronic devices from the tester interface upon completion of the testing.

Onishi in fig. 5-6 discloses all the elements and is silent about the steps (b) and (c) of claim 14 are **simultaneously operable**. Rather, Onishi discloses simultaneous testing of two groups of electronic devices (see fig. 6) in different trays 14. Onishi also discloses moving of tray 14 in a circular manner from and back to loader section 16 (see lines 50-55 of column 2). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to disconnect tray 14 from tester interface (test station 15b) and connect another tray 14 to a tester interface (station 15a) simultaneously as claimed, since circular movement of tray 14 in different test station for testing with other trays 14 loading after it for testing is art-recognize

equivalents and hence simultaneous steps as claimed would be within the level of ordinary skill in the art.

Regarding claim 16, Onishi in fig. 6 discloses the method as claimed in claim 14, further comprising a step of, **after the completion of step (d)**, unloading the first group [from 15b] and a second group [from 15a] of electronic devices from the test site.

Regarding claim 20, Onishi in fig. 6 discloses the method as claimed in claim 14, further comprising a plurality of subsequent test cycles (measurement cycles M) repeating the steps of the primary test cycle.

Regarding claim 15, Onishi in fig. 6-7 discloses all the elements except for the method as claimed in claim 14, further comprising a step of, **before the step (a)**, loading a first group and a second group of electronic devices to a test site. Onishi in fig. 8 (see lines 9-24 of column 5, particularly lines 15-17) discloses testing of electronic devices to a test site using synchronously operated two handlers 2-1 and 2-2 at the same time. Here, electronic devices of both groups (see 8 and 15 in fig. 8) are loaded to a test station (15) before testing. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to load first group and a second group of electronic devices as taught by Onishi in fig. 8 and then test the first group and a second group of electronic devices as thought in fig. 6, since selection of any of these known testing method would be within the level of ordinary skill in the art.

Response to Arguments

Applicant's argument/response filed 06/09/2005 have been fully considered but they are not persuasive. Examiner disagrees with Applicant assertion about connections. They are not illustrated in fig. 2 of the drawings as explained, particularly "second connection." First connection is a switch 120 and not the connection between connectors 122-124. First connection 120, which is alternately connects two device interfaces 130 and 230 respectively, see description of the first embodiment. First and Second connections as Applicant asserts does not alternate, therefore they are not First and Second connections as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 2829

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 571-272-1968. The examiner can normally be reached on 8:00 to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



July 22, 2005

Paresh Patel
Primary Examiner
Art Unit 2829